

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APP. NO. 10/049,422

REMARKS

Summary Of The Office Action

Claims 1-11 are pending in the application. Claims 4-11 are withdrawn from consideration.

Claims 1-3 are rejected under 35 U.S.C. § 102(e) as anticipated by Ohtani (USP 6,511,600).

Claims 1-3 are rejected under 35 U.S.C. § 102(e) as anticipated by Hopkins (USP 6,110,368).

Claims 1-3 are rejected under 35 U.S.C. § 103 as being unpatentable over Ohtani (USP 5,846,421) in view of Hopkins.

These rejections are respectfully traversed.

Preliminary Matters

Applicant's provisional election of claims 1-6 is affirmed.

Claims 4-6 are objected to as depending from a multiple dependent claim. Claims 4-6 are amended to remove the multiple dependency.

Rejection of claims 1-3

Regarding the rejection of claims 1-3 under 35 U.S.C. § 102(e) as anticipated by Ohtani (USP 6,511,600), Applicant notes that USP 6,511,600 is not a proper reference under 35 U.S.C. § 102(e), because this reference and the present application share the same inventive entity. Accordingly, Applicant requests that this rejection be withdrawn.

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We now turn to the rejection of claims 1-3 as being anticipated, or rendered obvious, by Hopkins. It is noted that in the Examiner's analysis of Hopkins, the Examiner does not give patentable weight to the feature wherein melting molding members in the component are "subjected to annealing." That is, the Examiner considers this to be a process limitation. Applicant submits, however, that annealing the molding members imparts a structural limitation. That is, a molding member that has been subjected to annealing has a different structure from a molding member that has not been subjected to annealing.

For example, as described beginning at page 21 of the specification, end plates are susceptible to cracking because of residual strains caused during the molding process. The residual strain can be removed by annealing the end plates. Thus the structure of the end plates is changed by the annealing process, and this change in structure imparts cracking resistance to the end plates.

MPEP section 2113 provides in part:

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and noting that terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations.)

(Emphasis added.)

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In claim 1, as explained above, the fact that members are subjected to annealing imparts distinctive structural characteristics to the final product. At least for this reason, Applicant submits that the Examiner has improperly failed to consider the feature wherein the members are subjected to annealing.

Because “at least one melting molding member of at least one of the components is an annealed member” is not shown or suggested in Hopkins, Applicant submits that claims 1-3 are patentable over this reference.

Turning to the rejection of claims 1-3 under 35 U.S.C. § 103 as being unpatentable over Ohtani (USP 5,846,421) in view of Hopkins, Applicant submits that these references, taken either alone or in combination, do not teach or suggest “at least one melting molding member of at least one of the components is an annealed member”, as required by claim 1.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

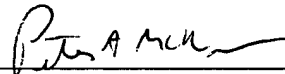
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